

REMARKS

Claims 1-8, 11-6, 21-27 and 29-34 have been amended. Accordingly, claims 1-34 are now pending.

Claims 2-8, 11-15, 23-26 and 31-34 have been amended to “the acts of” or “the act of” to make even more clear that none of the limitations in any of the claims invoke 35 U.S.C. §112, ¶6. Rather, where a limitation falls within 35 U.S.C. §112, ¶6, to aid in the public notice function of the claims applicants will explicitly recite either the phrase “means for ...” or “step for” Similarly, to aid in the public notice function of the claims, limitations not invoking 35 U.S.C. §112, ¶6 will not recite the phrase “means for” or “step for.”

Information Disclosure Statements

Apparently, the USPTO’s file is missing copies of some or all of the references for the Information Disclosure Statements (IDSs) submitted on July 10, 2002 and July 16, 2003, apparently indicated as the July 5, 2002 and July 21, 2003 Information Disclosure Statements in the Office Action. The Office Action did not contain copies of the Forms 1449 so Applicants can not determine exactly which references are missing from the PTO’s file.

It is pointed out that copies of all the references cited in Applicants’ Information Disclosure Statements were submitted to the PTO in connection with the present application. Accordingly, Applicants’ believe these Information Disclosure Statement were in compliance with the applicable rules including 37 CFR 1.98(a)(2). Nonetheless, to advance the prosecution of the present application, Applicants’ will happily supply additional copies of any needed references. In this regard, the present Office Action indicates that copies of any references

contained in the catalogue being maintained at the PTO need not be resubmitted. For the Examiner's benefit, such references are indicated in Attachment A to this Response.

Also pursuant to the Examiner's request, copies of references not listed in the catalogue are being re-submitted along with this Response.

The Office Action indicates that the Information Disclosure Statements of July 5, 2002 and July 21 2003 do not comply with 37 CFR 1.98(a)(3) because for some of the non-English references listed therein a concise explanation of the relevance has not been provided. The Office Action did not contain copies of the Forms 1449 so Applicants can not determine exactly which references have been found not to be in compliance. Nonetheless, Applicants respectfully traverse this conclusion.

July 10, 2002 IDS

The non-English patent references listed on the Form 1449 accompanying this IDS are believed to be references B1, B11, and B17-B25. As indicated on the Form 1449, either a translation of the patent or a translation of the Abstract has been provided for each such references.

The non-English "Other Document" references listed on the Form 1449 accompanying this IDS are believed to be references C49, C51, and C54. As indicated on the Form 1449, a translation of the each such reference was submitted, see references C50, C52-C53, and C55-C57.

Accordingly, this IDS is believed to be in compliance with 37 CFR 1.98(a)(3). If the PTO finds that additional non-English references were contained in this IDS for which the PTO believes the Applicants have not submitted a translation, Applicants respectfully request the Examiner to notify the Applicants.

July 16, 2003 IDS

It does not appear that this IDS contained any non-English references. Accordingly, this IDS is believed to be in compliance with 37 CFR 1.98(a)(3). If the PTO finds that additional non-English references were contained in this IDS for which the PTO believes the Applicants have not submitted a translation, Applicants respectfully request the Examiner to notify the Applicants.

As stated in the IDSs, in accordance with 37 C.F.R. §§ 1.97(g),(h), the Information Disclosure Statements are not to be construed as a representation that a search has been made, and is not to be construed to be an admission that the information disclosed is, or is considered to be, prior art with respect to the present application or material to patentability as defined in 37 C.F.R. §§ 1.56. In fact, Applicants are not aware of any obligation to perform a search of the prior art. Applicants, however, believe they have a duty to disclose information to the PTO which may be material to the present application. Under the current law, Applicants' attorney believes it is unwise to screen references from the PTO based on subjective beliefs. Rather, under the current law it appears most prudent to disclose any reference which has become associated with the present application to the PTO and allow the PTO to form its own conclusion as to the importance of any reference. See MPEP, 8th Ed., Rev. 1 §2001.04, p. 2000-3 ("The definition of materiality in **37 CFR 1.56** does not impose substantial new burdens on applicants, but is intended to provide the Office with the information it needs to make a proper and independent determination on patentability. It is the patent examiner who should make the determination after considering all the facts involved in the particular case.") (emphasis added) and p. 2000-4:

The Office does not anticipate any significant change in the quantity of information cited to the Office. Presumably, applicants will continue to submit information for consideration by the Office in applications rather than making

and relying on their own determinations of materiality. An incentive remains to submit the information to the Office because it will result in a strengthened patent and will avoid later questions of materiality and intent to deceive. In addition, the new rules will actually facilitate the filing of information since the burden of submitting information to the Office has been reduced by eliminating, in most cases, the requirement for a concise statement of the relevance of each item of information listed in an information disclosure statement. (Emphasis added.)

Accordingly, it does not appear that the withdrawal or the discussion of references is appropriate under existing law.

Additionally, Applicants point out that the present application is a continuation-in-part application; and therefore, pursuant to MPEP 609 (I)(A)(2) the “examiner will consider information which has been considered by the Office in a parent application” and “Such information need not be resubmitted in the continuing application....” More particularly, as previously identified, the present application is a continuation-in-part of U.S. Patent Application No. 09/635,967 (Atty Docket: 47171-00272) filed August 8, 2000 and entitled “Method and Apparatus for Document Processing.”

U.S. Patent Application No. 09/635,967 (Atty Docket: 47171-00272) is a continuation of U.S. Patent Application Serial No. 08/864,423 (Atty Docket 47171-00174), filed May 28, 1997 entitled “Method and Apparatus for Document Processing,” now issued as U.S. Pat. No. 6,311,819.

U.S. Patent Application Serial No. 08/864,423 claimed the benefit of Provisional Patent Application Serial Nos. 60/018,563 (Atty Docket 47171-158PZ1) filed May 29, 1996 entitled “Method and Apparatus for Document Identification and Authentication”, 60/034,954 (Atty Docket 47171-174PZ1) filed January 16, 1997 entitled “Method and Apparatus for Document Processing”, and 60/038,340 (Atty Docket 47171-174PZ2) filed February 27, 1997 entitled “Method and Apparatus for Document Processing,” all now abandoned.

Accordingly, even if Applicants had not resubmitted in the present application the references cited during the prosecution of the prior applications, the Examiner is still under a duty to consider such references. Nonetheless, to aid the Examiner and facilitate the review of the references cited during the prosecution of the prior applications, Applicants have attempted to list all such references in the first Information Disclosure Statement filed on July 10, 2002 as well as provide the Examiner copies of the same.

In a further attempt to aid the Examiner, Applicants attach as Exhibit B a copy of the Form 1449 for the first IDS. Check marks on Exhibit B indicate which references Applicants believe were cited during the prosecution of one or more of the parent applications. Moreover, it is believed that all checked marked references were cited during the prosecution history of the immediate parent application, U.S. Patent Application No. 09/635,967. As can be seen from a review of Exhibit B, the vast majority of references were previously cited. Conversely, any non-check marked references in Exhibit B are believed to be newly cited in this application.

No comments were made in the Office Action concerning the Information Disclosure Statement (IDS) submitted on November 21, 2003; and therefore, Applicants assume that the PTO has no objections to this IDS.

Accordingly, Applicants respectfully submit that the Information Disclosure Statements are in compliance with the applicable rules and respectfully ask that all references be considered and that initialed Forms 1449 be placed in the file and copies thereof returned to the Applicants.

Specification

Applicants note the remark in the Office Action about pages 79, line 29 – page 103 of the specification but are not clear as to the meaning of “back up the claims.” It is also pointed out

that in the Interview Summary and Applicants' Statement of the Substance of the Interview that other portions of the specification were referenced such as FIGs. 32-39 and the accompanying text. Also, it is pointed out that the specification (*e.g.*, at p. 62, l. 26 – p. 63, l. 10) contains at least some disclosure similar to that found by the Examiner in Weggesser (see §102(f) rejection below).

“One embodiment”

On page 4 of the Office Action it is recognized that the drawings in this application contain multiple embodiments. Nonetheless, the Office Action states that the term “one embodiment” as found in the specification is misleading “because it neither says that all of the drawings are to a ‘single embodiment’ nor does it specify that the drawings are to ‘multiple embodiments.’” The Office Action then states some form of correction is required.

Applicants respectfully traverse this “note.” To begin with, Applicants do not believe that the term “one embodiment” is misleading. In fact, the Office Action itself recognizes that the specification does not suggest that all of the drawings are to a single embodiment. Therefore, Applicants are confused as to how the use of this term is misleading. Additionally, the Office Action does not identify which uses of the term “one embodiment” are found to be confusing and require correction. Also, the Office Action does not indicate how the Examiner would like the Applicants to revise the specification. Without knowing which uses of the term “one embodiment” are found to be confusing or how the Examiner suggests the specification should be revised, Applicants are unable to adequately respond.

Nonetheless, in an effort to advance the prosecution of this case, if the concern is directed to the Brief Description of the Drawings found on pages 4-8, the Examiner is requested

to consider two possible changes: (1) the change of “one embodiment” to “some embodiments” or (2) the deletion of phrases such as “according to one embodiment of the present invention.”

Alternative Embodiments

On page 4, the Office Action suggests that some kind of correction is desired with respect to the section titled “Alternative Embodiments.” Applicants are confused as to what is being asked for and what the basis for such a request is. Accordingly, Applicants respectfully request clarification as to which Rule is asserted as being violated and how it is suggested that the specification should be modified.

Title

The Office Action requested that the title be changed. Accordingly, the title has been changed to “Multiple Pocket Currency Bill Processing Device and Method.”

§102(f) Rejections

Claims 1-34 were rejected under 35 U.S.C. 102(f) in view of U.S. Pat. No. 5,938,044 to Weggesser (“Weggesser”). This rejection is respectfully traversed because Weggesser is not prior art with respect to the instant application. Weggesser has a filing date of March 10, 1997. The present application claims priority to, *inter alia*, Provisional Patent Application Serial No. 60/038,340 (Atty Docket 47171-174PZ2) filed February 27, 1997. Although not entirely clear from the Office Action, it appears that the portion of Weggesser relied upon for the rejection is col. 41, ll. 10-34. This passage also appears Provisional Patent Application Serial No. 60/038,340 at page 42, lines 1-18. Accordingly, applicants respectfully request this rejection to be withdrawn.

Additionally, it is pointed out that reference A244 corresponds to one of the parent applications (U.S. Patent Application Serial No. 08/864,423 now issued as U.S. Pat. No. 6,311,819) and is believed to likely contain at least some disclosure similar to that found by the Examiner in Weggesser (see, *e.g.*, A244, col. 30, ll. 33-56).

§103 Rejections

Claims 6-34 were rejected under 35 U.S.C. §103(a) in view of U.S. Pat. No. 4,963,118 to Gunn ("Gunn"). The Office Action also refers to a four line abstract of JP0360093580A to Kaneko ("Kaneko Abstract").

Gunn relates to a coin sorting device and as recognized by the Office Action does not teach or suggest anything with respect to devices which handle currency bills. In fact, Gunn is non-analogous art, it long being recognized that the art of handling coins is separate and distinct from the art of handling currency bills. Moreover, those skilled in the art of currency bill denominating equipment would not be expected or motivated to look to the art of coin handling equipment. Accordingly, because Gunn is non-analogous art, applicants respectfully request this rejection to be withdrawn.

Additionally, in the Office Action dated September 29, 2003, claims 16-22 and 27-30 have already been found to be patentably distinct from claims 1-15, 23-26 and 31-34. Moreover, the Office Action dated September 29, 2003 recognized that these two grouping of claims "have acquired a separate status in the art." Therefore, it follows that these claims which are all directed to currency bills are patentably distinct from Gunn which is not even directed to currency bills, but coins.

The Office Action refers to Kaneko Abstract for the broad proposition that it teaches that it would be obvious to apply any concept that relates to one type of currency to a second type of

currency. However, the Kaneko Abstract does not teach such a proposition. Rather, the Kaneko Abstract merely refers to some kind of device which apparently has an opening to accept a coin and another opening to accept a piece of paper money. However, the Kaneko Abstract does not teach or disclose that it would process a coin in the same manner using the same structures as it would use to process a piece of paper currency. In fact, by its reference to a coin slot, if anything it suggests that the two types of currency should be handled and processed separately, using separate mechanisms – one for a coin and a separate one for a paper currency bill. Accordingly, the Abstract does not teach the broad proposition suggested in the Office Action.

Thus the Kaneko Abstract does not disturb the non-analogous status of the art of coin handling equipment and the separate art of bill denominating equipment. According, the applicants respectfully request the present rejections to be withdrawn.

Moreover, neither Gunn nor Kaneko nor the combination thereof teaches or suggests the claimed devices and methods. For example, neither Gunn nor Kaneko nor the combination thereof teaches or suggests, *inter alia*, “an operator interface adapted to permit the operator of the device to change the designation of each one of the output receptacles between being a fixed pocket and being a dynamic pocket” as recited in claim 21. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests, *inter alia*, “an operator interface adapted to permit the operator of the device to change the designation of each of the output receptacles between being a fixed pocket and being a dynamic pocket, wherein a fixed pocket is a pocket assigned to a particular denomination such that during normal operation only bills of the particular denomination may be transported to the fixed output receptacle and wherein a dynamic pocket is a subject to dynamic assignment of a bill denomination during normal operation of the denominating device” as recited in claim 22. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests the acts of:

- (A) transporting currency bills from the input receptacle past a bill denominating sensor;
- (B) determining the denomination of a first transported bill;
- (C) associating a first denomination with a first one of the output receptacles wherein the first denomination is the denomination of the first transported bill and delivering the first transported bill to the first one of the output receptacles;
- (D) determining the denomination of subsequent transported bills;
- (E) upon first encountering a transported bill having a denomination other than the first denomination, defining a second denomination as the denomination of the transported bill having a denomination other than the first denomination and associating the second denomination with a second one of the output receptacles;
- (F) delivering bills having the first denomination to the first output receptacle;
- (G) delivering bills having the second denomination to the second output receptacle;
- (H) monitoring whether the first output receptacle has been cleared of bills;
- (I) monitoring whether the second output receptacle has been cleared of bills;
- (J) upon encountering a transported bill having a denomination other than the first or second denominations, determining whether either the first or second output receptacle has been cleared of bills and if so,
 - (i) redefining the first denomination to be the denomination of the bill having a denomination other than the first or second denominations if the first output receptacle has been cleared and delivering the bill to the first output receptacle;
 - (ii) redefining the second denomination to be the denomination of the bill having a denomination other than the first or second denominations if the second output receptacle has been cleared and delivering the bill to the second output receptacle;
- (K) repeating steps (F) – (J).

as recited in claim 23. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests the acts of:

- (A) transporting bills from the input receptacle past a bill denominating sensor;

- (B) determining the denomination of the bills;
- (C) determining the first denomination of the bills encountered;
- (D) determining the second denomination of the bills encountered;
- (E) associating the first denomination with a first one of the output receptacles;
- (F) associating the second denomination with a second one of the output receptacles;
- (G) delivering bills having the first denomination to the first output receptacle;
- (H) delivering bills having the second denomination to the second output receptacle;
- (I) monitoring whether the first output receptacle has been cleared of bills;
- (J) monitoring whether the second output receptacle has been cleared of bills;
- (K) upon encountering a bill having a denomination other than the first or second denominations, determining whether either the first or second output receptacle has been cleared of bills and if so,
 - (i) redefining the first denomination to be the denomination of the bill having a denomination other than the first or second denominations if the first output receptacle has been cleared;
 - (ii) redefining the second denomination to be the denomination of the bill having a denomination other than the first or second denominations if the second output receptacle has been cleared;
- (L) repeating steps (E) – (K).

as recited in claim 25. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests the acts of:

- (A) transporting bills from the input receptacle past a bill denominating sensor;
- (B) determining the denomination of the bills;
- (C) determining the first denomination of the bills encountered;
- (D) determining the second denomination of the bills encountered;
- (E) associating the first denomination with a first one of the output receptacles;
- (F) associating the second denomination with a second one of the output receptacles;
- (G) delivering bills having the first denomination to the first output receptacle;
- (H) delivering bills having the second denomination to the second output receptacle.

as recited in claim 26. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests:

a currency bill input receptacle,
a plurality of currency bill output receptacles,
a transport mechanism adapted to individually transport bills from the input receptacle to the output receptacles and
a processor adapted to control of the operation of the device, the processor being programmed to:

- (A) cause bills to be transported from the input receptacle past a bill denominating sensor;
- (B) determine the denomination of a first transported bill;
- (C) associate a first denomination with a first one of the output receptacles wherein the first denomination is the denomination of the first transported bill and cause the first transported bill to be delivered to the first one of the output receptacles;
- (D) determine the denomination of subsequent transported bills;
- (E) upon first encountering a transported bill having a denomination other than the first denomination, define a second denomination as the denomination of the transported bill having a denomination other than the first denomination and associate the second denomination with a second one of the output receptacles;
- (F) cause bills having the first denomination to be delivered to the first output receptacle;
- (G) cause bills having the second denomination to be delivered to the second output receptacle;
- (H) monitor whether the first output receptacle has been cleared of bills;
- (I) monitor whether the second output receptacle has been cleared of bills;
- (J) upon encountering a transported bill having a denomination other than the first or second denominations, determine whether either the first or second output receptacle has been cleared of bills and if so,
 - (i) redefine the first denomination to be the denomination of the bill having a denomination other than the first or second denominations if the first output receptacle has been cleared and cause the bill to be delivered to the first output receptacle;

- (ii) redefine the second denomination to be the denomination of the bill having a denomination other than the first or second denominations if the second output receptacle has been cleared and cause the bill to be delivered to the second output receptacle;

(K) repeating steps (F) – (J).

as recited in claim 27. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests:

a currency bill input receptacle,
a plurality of currency bill output receptacles,
a transport mechanism adapted to individually transport bills from the input receptacle to the output receptacles and
a processor adapted to control of the operation of the device, the processor being
programmed to:

- (A) cause bills to be transported from the input receptacle past a bill denominating sensor;
- (B) determine the denomination of the bills;
- (C) determine the first denomination of the bills encountered;
- (D) determine the second denomination of the bills encountered;
- (E) associate the first denomination with a first one of the output receptacles;
- (F) associate the second denomination with a second one of the output receptacles;
- (G) cause bills having the first denomination to be delivered to the first output receptacle;
- (H) cause bills having the second denomination to be delivered to the second output receptacle;
- (I) monitor whether the first output receptacle has been cleared of bills;
- (J) monitor whether the second output receptacle has been cleared of bills;
- (K) upon encountering a bill having a denomination other than the first or second denominations, determine whether either the first or second output receptacle has been cleared of bills and if so,

- (i) redefine the first denomination to be the denomination of the bill having a denomination other than the first or second denominations if the first output receptacle has been cleared;
- (ii) redefine the second denomination to be the denomination of the bill having a denomination other than the first or second denominations if the second output receptacle has been cleared;
- (L) repeating steps (E) – (K).

as recited in claim 29. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests:

a currency bill input receptacle,
a plurality of currency bill output receptacles,
a transport mechanism adapted to individually transport bills from the input receptacle to the output receptacles and
a processor adapted to control of the operation of the device, the processor being
programmed to:

- (A) cause bills to be transported from the input receptacle past a bill denominating sensor;
- (B) determine the denomination of the bills;
- (C) determine the first denomination of the bills encountered;
- (D) determine the second denomination of the bills encountered;
- (E) associate the first denomination with a first one of the output receptacles;
- (F) associate the second denomination with a second one of the output receptacles;
- (G) cause bills having the first denomination to be delivered to the first output receptacle; and
- (H) cause bills having the second denomination to be delivered to the second output receptacle.

as recited in claim 30. Neither Gunn nor Kaneko nor the combination thereof teaches or suggests the acts of, inter alia:

generating a denomination change error upon first encountering a bill not having the first target denomination;

designating a second target denomination to be the denomination of the bill causing generating the first denomination change error upon the first occurrence of a denomination change error,

routing bills having a second target denomination to the second output receptacle; upon encountering a bill having neither the first target denomination nor the second target denomination, then generating a denomination change error and

- a) stopping the operation of the device if both the first and the second output receptacles have one or more bills therein; or
- b) routing the bill having neither the first target denomination nor the second target denomination to an empty one of the first and second output receptacles if one of the output receptacles is empty and resetting the first target denomination to be the denomination of the bill if the bill is routed to the first output receptacle and resetting the second target denomination to be the denomination of the bill if the bill is routed to the second output receptacle.

as recited in claim 31. Accordingly, applicants respectfully request this rejection to be withdrawn.

It is the Applicant's belief that all of the claims are now in condition for allowance, and action towards that end is respectfully requested.

If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

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Respectfully submitted

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